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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/972,313	11/18/1997	THOMAS BOONE PICKENS III	2281	5434

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EXAMINER

TREMBLAY, MARK STEPHEN

ART UNIT PAPER NUMBER

2827

DATE MAILED: 06/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/972,313

Applicant(s)

PICKENS, THOMAS BOONE

Examiner

Mark Tremblay

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 13-20 and 23-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 13-20 and 23-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 November 1997 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Applicant: Thomas Boone Pickens III

Filing date: 11/18/97

Part III Action on the Merits

5

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10 Claims 1-9, 13-20, and 23-27 are rejected under 35 U.S.C. 112, second paragraph, as
being indefinite for failing to particularly point out and distinctly claim the subject matter which
applicant regards as the invention. All of the claims contain the limitation "unaffiliated with an
entity that created the graphical code." This recitation is vague and indefinite. The term
"unaffiliated" is indefinite. Websters II New Riverside dictionary defines the term "affiliate" as 1.
to accept as a subordinate associate. 2. To associate (oneself) with. It is unclear which definition
15 Applicant has in mind. Would a delivery person be a subordinate associate of a delivery
company? Or, would a delivery person working for a delivery company be a subordinate
associate of another company that printed a delivery label? Or would that fall under the second
definition? Would a customer be affiliated with a vendor, or unaffiliated?

20 The next term "entity" is also indefinite. Does the applicant mean a legal entity, such as a
corporation, or a person, or a printer?

The phrase as a whole is ambiguous, because it is not clear how to interpret it in the
following way: Inventors at Symbol Technology invented the graphical code PDF 417. If United
Parcel Services encodes an address into PDF 417 and prints it, which entity would be deemed by
the claim to have created the graphical code?

25 The phrase as a whole is also indefinite in the following sense: John, an employee of
Microsoft, uses Windows, third-party bar code software, and a laser printer to print a PDF 417
code. He puts the code on a package and gives it to UPS, as required by the contract Microsoft
has with UPS, which specifies the code type, format, and contents of the code. What entity
created the code? The claim language would not clearly inform Microsoft and UPS whether they
30 would be in an infringing situation, because the claim language is vague and indefinite.

As another example, ACE Packaging Company prints a symbol containing URL information on a package for the MS6740 bar code scanner manufactured by Metrologic. The symbol is specified by Metrologic, but printed by ACE Packaging Company. Which entity "created" the graphical code? Is Applicant's claim language relevant, simply because most people would think that ACE created the code, and is unaffiliated with Metrologic?

Drawings

Figures 1-1A should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(c)).

Claims 1-2, 4-6, 9, 15-16 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent #5,869,819 to Knowles et al. ("Knowles" hereinafter). Knowles discloses an optical scanning system, comprising:

a two dimensional graphical code displayed on the object (see column 21, lines 54-64), wherein the graphical code comprises an encoded Internet address (URL) and additional information (zip code);

scanning means (e.g. 53A) for optically scanning the graphical code; and

a computer (e.g. 53C) connected to the scanning means and further comprising processing means for decoding the scanned encoded Internet address and additional information (see figures 15 and 16, and elsewhere). Knowles does not need to teach such a scanner "wherein an individual obtains data related to an item by scanning the two dimensional graphical code with the scanning means, and wherein the individual is not affiliated with an entity that created the graphical code." 5 in order to anticipate these claims under 35 U.S.C. §102, because this portion of the claim fails to further limit an "optical scanning system, comprising". The recitation is an intended use, and does not modify the structure being claimed. For example, in Knowles, the device would not function any differently if the person operating the scanner was the delivery man, a sales man, a customer, 10 or a random person walking by. For example, if Metrologic was trying to sell the optical scanning system to UPS, and a Metrologic salesman who printed out a few codes was demonstrating the scanner to a UPS IT acquisition representative, would the scanner operate any differently when the Metrologic sales person handed it to the UPS representative, and said "Here, try it,"? The UPS representative clearly would not have created the code, and would not be seen as being 15 affiliated with Metrologic. So, it would be impossible to look at the optical scanner's structure, and decide whether the structure met the limitation, "wherein an individual obtains data related to an item by scanning the two dimensional graphical code with the scanning means, and wherein the individual is not affiliated with an entity that created the graphical code."

Examiner also notes the following passage in Knowles: "In order to indicate that a 20 particular printed publication or object bears a URL-encoded bar code symbol according to the present invention, and not a conventional bar code symbol (e.g., UPC Symbol), it may be advantageous to print the entire or primary portion of the encoded URL (e.g., <http://www.metrologic.com>) about the perimeters of the URL-encoded bar code symbol, in a similar way that UPC numbers are printed below UPC-type bar code symbols. This printing 25 convention, once adopted, will help consumers determine which bar code symbols provide "Internet Access", in contrast with other types of bar code symbols." This clearly teaches the recited limitation. Further, in figures 8 and 9, bar codes which point to a product information web site are clearly shown. The MS 6720 is a bar code scanner produced by Metrologic. The web page is for customers. While the address listed in the patent is no longer valid, a similar address at

Metrologic, <http://www.metrologic.com/corporate/products/pos/MS6720.htm>, gives information about the 6720 scanner to potential customers. The address shown in figures 8 and 9, and the passage above, clearly teach the need to give information to individuals seeking information, and the individuals are unaffiliated with the entity that created the graphical code.

5 Re claim 6, Knowles clearly depicts a detachable scanner 7A in figure 11.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

10 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15 Claims 3, 7, 8, and 13-14 drawn to an optical scanning system, and claims 17-20, and 23-27 drawn to an optical scanning method, and claim 27, drawn to a process of printing a graphical code are rejected under 35 U.S.C. § 103 as being unpatentable over Knowles.

20 Re claims 17-27, the limitation regarding "wherein the individual is not affiliated with an entity that created the graphical code," when interpreted in light of Applicant's specification and remarks, appears to apply to the case of, for example, a customer at a soda machine, or a magazine consumer, seeking information about the products of a corporation. However, Knowles, as described above, clearly teaches this feature. It would have been obvious at the time the invention was made to a person having ordinary skill in the art for a product manufacturer to

25 create a graphical symbol that identifies or relates to a product and a web site, because this is what is clearly suggested by figures 8 and 9 of Knowles. Knowles is assigned to the bar code manufacturer Metrologic. Metrologic maintains a web site with information about its products for its customers and potential customers. An example is the MS 6740 bar code scanner. Figures 8 and 9 illustrate a bar code that suggest a reference to product information on the manufacturer's

30 web site. Obviously, since products are typically packaged in packages with printed graphical information on them, the packaging for the MS 6740 scanner would be an obvious place to put the bar codes illustrated in figures 8 and 9. That way, a customer or potential customer could get

product information and updates about this scanner. The customer would be unaffiliated with the entity that created the bar code. But the customer would use the code printed on the package to retrieve information about the MS 6740 bar code scanner. This is obviously suggested, or alternatively directly taught, by figures 8 and 9.

5 Re claim 3, a wireless connection link to an ISP is taught by Knowles in column 8, lines 11-27, and in figure 17 as well known in the art. Wireless modems were well known in the art at the time the invention was made for connecting to the Internet, and this is clearly suggested by Knowles. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use a well known wireless modem to connect to the Internet as depicted
10 in figure 17 because a wireless modem accomplishes the wireless link from a hand held unit to a server computer as depicted in figure 17 of Knowles.

Re claim 7, Official Notice is taken that wireless Infrared scanners were old and well known in the art. See In Re Malcolm 1942 C.D.589:543 O.G. 440. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use an wireless
15 infrared scanner to perform the wireless link suggested by Knowles because Knowles relies on wireless links known in the art without specifying the details and wireless infrared links were well known in the art.

Re claim 8 and 19-20, see figure 4. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the embodiments shown in figure
20 4 and figures 11-18 because this would allow a user to use known free web browsers to perform the invention of figures 11-18. This is clearly suggested by the teaching as a whole.

Re claims 9, 20 and 26, in figures 8 and 9, "ms6740" is a representation of the object. It would further be obvious, as stated above, to include the information shown in these figures on the packaging of a ms6740 scanner, because this would allow the user to obtain additional and
25 updated information about the product which is not possible to print on the package, but is possible to provide on a web site. Information that was typically found on web sites, such as full specifications, data sheets, product brochures, white papers, options, warranty details, volume pricing schedules, driver updates, magazine reviews, and other promotional information that cannot possibly all be printed on product packaging would be referenced by a bar code on a

package such as that shown in figures 8 and 9. Also, Knowles clearly teaches the use of magazines or catalogs to reference product information, which contain product representations in advertisements, as is well known.

Re claim 13 and 23-24, note that the bar code on the top of the Knowles patent is approximately 7mm high. Smaller bar code heights are old and well known.

Re claims 14, 25 and 27, the zip code is included. If the complete zip plus 4 is included, this would be all the information needed in many cases to deliver the parcel. Alternatively, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to encode the zip code plus the entire address of the intended recipient, in order to facilitate routing the package more completely. Examiner notes that the intended recipient and delivery location is related to the object, in that the object is presumably owned and intended to be delivered according to the information in the bar code. Further, using the example of figures 8 and 9, the model number of the product is related to the object.

Voice

Inquiries for the Examiner should be directed to Mark Tremblay at (703) 305-5176. The Examiner's regular office hours are 10:30 am to 7:00 pm EST Monday to Friday. Voice mail is available. If Applicant has trouble contacting the Examiner, the Supervisory Patent Examiner, Michael Lee, can be reached on (703) 305-3503. Technical questions and comments concerning PTO procedures may be directed to the Patent Assistance Center hotline at 1-800-786-9199 or (703) 308-4357.


MARK TREMBLAY
PRIMARY EXAMINER

June 15, 2003